

Appln. No. 09/660,328
Amd. dated November 17, 2003
Reply to Office Action of September 16, 2003

REMARKS

The Office Action has been carefully reviewed. The examiner considers the claims to be directed to five separate inventions and requires restriction to one of the following groups:

Group I, drawn to a method of diagnosing prostate cancer, and presently comprising claims 52-77 and 113;

Group II, drawn to methods of diagnosing breast cancer, and presently comprising claims 78-103 and 113;

Group III, drawn to a diagnostic test for confirming prostate or breast cancer, and presently comprising claims 104-106;

Group IV, drawn to a method of detecting agents causing genomic destabilization, and presently comprising claims 107; and

Group V, drawn to methods of correlating allele miscoordination in cells with cancer-causing or anti-cancer properties of compounds, and presently comprising claims 108-112.

Applicants elect Group I, drawn to a method for diagnosing prostate cancer and presently comprising claims 52-77 and 113, with traverse. Non-elected claims 104-112 (Groups III-V) are now cancelled without prejudice to the filing of a divisional application(s) thereon. Traversal of the restriction

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requirement insofar as Groups I and II are concerned is based on the fact that the same steps are performed in the method for diagnosing prostate cancer as that for diagnosing breast cancer. This is made clear by new claim 113, which is drawn to a method for diagnosing prostate or breast cancer, where the method steps are the same with the exception that the individuals who would be tested and diagnosed with prostate cancer are males and the individuals who would be tested and diagnosed with breast cancer are females. New claim 113 links Groups I and II.

As the search for both Groups I and II are both classified in the same class 435, subclass 6, and the method steps and dependent claims are the same whether the method is for diagnosis of prostate cancer or breast cancer, it is believed that the searches for Groups I and II are coextensive and there is no burden on the examiner to examine both Groups I and II together. The second paragraph of MPEP §803 requires that there be a "serious burden" in order to make a restriction requirement, even if the requirement is otherwise correct.

Withdrawal of the restriction requirement insofar as Groups I and II are concerned is respectfully requested.

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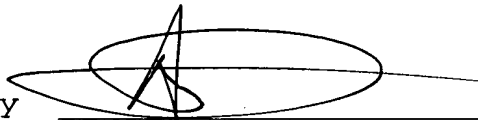
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Favorable consideration and examination of Groups I and
II are respectfully solicited.

Respectfully submitted,

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